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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/050,060 01/31/94 ROBSON

EXAMINER
D. P. B. 005410

ART UNIT PAPER NUMBER

DOM1/0918

15

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111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5127
This communication is from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED:
1995

09/18/95

☐ This application has been examined ☒ Responsive to communication filed on 6/19/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 3-6, 8-17, 20-22 and 24 are pending in the application.

Of the above, claims — are withdrawn from consideration.

2. ☐ Claims — have been cancelled.

3. ☐ Claims — are allowed.

4. ☒ Claims 1, 3-6, 8-17, 20-22 and 24 are rejected.

5. ☐ Claims — are objected to.

6. ☐ Claims — are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on —. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on —, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed —, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. —; filed on —.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 1308

Claims 8 and 9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims depend from a canceled claim (i.e. claim 7), and are therefore indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 9-13 and 16 are again rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Teng et al. (U.S. Patent No. 3,788,984, hereinafter "Teng '984").

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Claims 3, 4, 8, 15, 17 and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Teng '984. The reference discloses the claimed invention with the exception of the weight gain of the treated material (claims 3 and 4), the type of lignocellulosic material employed (claim 8), the type of oil removed (claims 15 and 17), and the physical form (i.e. sheet) of this material (claim 22). However, the exact weight gain of the reference material after treatment, its type and physical form, and the exact type of oil removed are not seen to be result effective variables, and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 14, 20, 21 and 24 are rejected under 35 U.S.C. § 103 as being unpatentable over Teng '984 in view of Fahlvik. The primary reference discloses the claimed invention with the exception of the outer covering for the modified plant material. Fahlvik discloses encasing a cellulosic oil absorbent material in a mesh covering. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified plant material of the primary reference with the covering of the secondary reference, in order to facilitate handling of this primary reference material.

Applicants' arguments filed February 24, 1995, April 21, 1995 and June 19, 1995 have been fully considered but they are

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not deemed to be persuasive. Applicants argue that Teng '984 does not contemplate modification of the hydroxyl groups of the lignin in the starting material. This argument has been noted and carefully considered, but is not deemed to be persuasive of patentability. It is pointed out that Teng '984 subjects a lignocellulosic material such as sawdust (col. 3, line 35) or paper (col. 3, lines 39-40) to esterification with acetic anhydride (col. 2, line 61). Since this procedure appears to be identical to that used by Applicants to produce their product (see page 3, lines 11 and 29 of the specification), the reference material is deemed to be patentably indistinguishable from the material recited in the claims of this application.

Applicants apparently feel that claims 14, 20, 21 and 24 should stand or fall with the other claims in this application, since no arguments have been presented as to why the additional limitations contained in these claims are sufficient to distinguish them over the references of record. In any event, Fahlvik discloses encasing a cellulosic oil absorbent material in a mesh covering; and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified plant material of Teng '984 with the covering of Fahlvik, in order to facilitate handling of this primary reference material.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for this Group is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Ivars Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1308

I. Cintins
September 17, 1995